

REMARKS

Claims 1-17 are pending with claims 1, 4, 10, 12 and 13 amended herein. In addition, the specification is amended to correct minor informalities found therein and Fig. 21 is corrected, at step S109, to correct the spelling of "producing."

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Lugo in the May 18 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

Applicants appreciate Examiner Lugo providing, at the interview, an initialed Form PTO-1449 from the June 18, 2003 filed Information Disclosure Statement thereby completing Applicants' records.

In paragraph 3, on page 2 of the Office Action, claims 1-3, 6 and 11-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over RubberStampsNow.com (Rubber Stamps) in view of CurrentChecks.com (Checks Unlimited) in view of U.S. Patent No. 6,134,548 to Gottsman et al. (hereinafter "Gottsman") and further in view of U.S. Patent No. 6,594,642 to Lemchen. The rejection is respectfully traversed.

Included in this rejection are three independent claims, 1, 12 and 13. Claims 1 and 12 are directed to an automated personalized product producing system for producing a personalized product in response to each request from customers and claim 13 directed to an automated method of providing a personalized product in response to each request from a customer.

Claim 1 then states that the system comprises an electronic mail (e-mail) receiver that can receive pieces of e-mail from each customer, by wireless communication, each piece of e-mail containing data on a requested personalized product along with customer information; an e-mail returning device that automatically generates and returns, upon receipt of each piece of e-mail by the e-mail receiver, a piece of e-mail for acknowledging receipt of each request to

each of the customers, based on the customer information; an electronic data analyzer that analyzes contents of each piece of e-mail received by the e-mail receiver and electronically converts the e-mail data on the requested personalized product to electronic image data to be used to create the personalized product; a personalized product producing device that directly receives the electronic image data from the electronic data analyzer and outputs an image on an output medium, and uses the output medium to create the personalized product; and an e-mail mail transmitter that automatically generates and transmits a piece of e-mail for notifying each of the customers of completion of production of the request of personalized product by the personalized product producing device.

Without addressing the issue of whether Rubber Stamps and Checks Unlimited are, in fact, prior art, that issue having been addressed in detail in the Amendment filed December 29, 2003, Applicants do not agree that Rubber Stamps discloses a personalized product producing system in any way, shape and/or form. What Rubber Stamps discloses is an electronic ordering system that allows one to order various types of stamps. The relationship between the ordering system and the actual stamp producing device or method is not addressed in the reference.

As evidenced by all the other references shown, there are myriad number of ways of linking an ordering system to what might be the end product producer. In fact, Arledge, Jr. et al., U.S. Patent No. 6,535,294 (hereinafter "Arledge"), shows an ordering system that passes through the retailer, that appears to be the ordering facility, directly to a wholesaler that produces the products and may either ship them to the retailer or to the customer once the retailer has approved the order. Thus, the only thing that can be said about Rubber Stamps is it allows e-mail orders as indicated on page 2 of that reference. Thus, Rubber Stamps does not show an e-mail returning device, an electronic data analyzer, a personalized producing device or an e-mail transmitter for automatically generating and transmitting notification. No matter how

much one desires to pervert the doctrine of inherency, one cannot go beyond that which is disclosed in the reference and, in the case of Rubber Stamps, the only thing disclosed is an ordering system.

As to Checks Unlimited, it states that the predecessor company Current Checks was established as a direct mail check printer in 1986. The reference then goes on to indicate that Checks Unlimited today produces a full line of check and label related products. However, what is disclosed is simply a check ordering system along with a list of frequently asked questions (FAQs) and replies thereto. The system does indicate that orders may be presented by e-mail. Further, on page 6 of the reference, it states in response to the frequently asked question of "when electronic e-mail will be sent for confirmation" that if the address is correct the orderer can expect to receive an e-mail confirmation between 24 and 48 hours after the order was placed. This does not indicate an e-mail returning device that automatically generates and returns such an answer. In fact, given the delay, one would believe that it is a manual return after the order has been reviewed and accepted or rejected. Further, there is nothing in the Checks Unlimited document that indicates that the system is an automated personalized product producing system. Rather, it appears to be a very segmented system in which an order is placed and then a series of unknown actions are taken to produce the order. Among those actions is a confirmation of the order. This system also allows e-mail inquiries. This is indicated by the frequently asked question "what is your e-mail address?" on page 7. However, this combination does not suggest an automatic feedback service.

Gottzman then is applied show the use of cellular palm devices, known as wireless devices, to send and receive e-mails. Although, this may be true, Gottzman does not overcome the deficiencies of either Rubber Stamps or Checks Unlimited as to showing an automated personalized product producing system. Thus, the addition of Gottzman to the combination does not suggest the invention of claim 1.

Lastly, Lemchen is added for teaching it is known to have electronic data analyzer that receives data and converts it to electronic data for personalized products. Lemchen is directed to a robotic manufacturing machine or system that offers options through a web server for multiple physical features of a product later presented to a consumer via the Internet (col. 2, lines 26-30). The intended user is not necessarily, and in most cases is not, the actual customer, rather is a middle man. All the examples cited are for specialized products for which one would normally go to a professional who would help define the requirements or needs and then that professional normally would input the requirements to obtain the desired product (col. 2, lines 30-39; and col. 3, line 64-col. 4, line 1). Such, added to the combination, does not suggest the subject matter of claim 1. Applicants' claim 12 has similar features to claim 1 and adds a data transmitter that can automatically transmit in reply to a customer request, at least one of an acknowledgement of the request, an estimate of personalized product availability time, and a report of personalized product availability. There is no indication that any of the references provide such an automated service.

As to claim 13, it is directed to a method of providing a personalized product which includes an automated method to include automatic notification to the customer that the personalized product is completed. None of the references disclose or suggest such a method. Thus, claims 1, 12 and 13 are allowable over the applied references. Further, claims 2, 3, 6, 11, 14 and 15 are allowable for all the reasons claim 1 is allowable as well as for the additional features recited therein; and claims 16 and 17 are allowable for all the reasons claims 13 and 12, respectively, are allowable and for the additional features recited therein. It is respectfully requested that the rejections be withdrawn.

In paragraph 4, on page 5 of the Office Action, claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamps in view of Checks Unlimited in view of

Gottzman in view of Lemchen and further in view of Arledge. The rejection is respectfully traversed.

Arledge is cited for disclosing a storage device, for storing information about the user and, allegedly, previous products for the user. Arledge really deals with producing printed products wherein orders are placed over the Internet. The orders are placed through a retailer site and, through an invisible, to the user, connection pass directly to a wholesaler. When the wholesaler has prepared data on the order, an e-mail is sent to the retailer instructing the retailer to log on to the wholesaler site to review the order information and approve that order information (col. 4, lines 13-27). This is compared to Applicants' claim 4 which calls for an automated personalized product producing system for producing a personalized product in response to each customer's request from customers, the system comprising an electronic mail (e-mail) receiver that can receive pieces of e-mail from each customer, by wireless communication, each piece of e-mail containing data on a requested personalized product along with customer information; an e-mail returning device that automatically generates and returns, upon receipt of each piece of e-mail by the e-mail receiver, a piece of e-mail for acknowledging receipt for each request to each of the customers, based on the customer information; an electronic data analyzer that analyzes contents of each piece of e-mail received by the e-mail receiver and converts the data on the requested personalized product to image data to be outputted to create an output medium; a personalized product producing device that directly receives the image data and outputs an image on the output medium, and uses the output medium to create the personalized product; an e-mail transmitter that automatically generates and transmits a piece of e-mail for notifying each of the customers of completion of production of the requested personalized product by the personalized product producing device; and a storage device for storing a produced personalized product in association with customer information wherein the storage device authenticates each of the customers based on the

customer information and upon confirmation of authenticity of each of the customers, provides the stored personalized product associated with the customer information to each of the customers.

Thus, Arledge does not appear to disclose a storage device for storing a personalized product in the context of Applicants' claimed invention. Arledge actually talks about the methodology of producing the products but says nothing about storing the products or delivering the products ultimately to the customers, the delivery following authentication. This contrasts with Applicants' invention wherein the storage devices are clearly described in the specification in, for example, paragraphs [0135] or [0140]. Further, Arledge does not overcome the deficiencies of the other references with respect to the basic features of claim 4 which are substantially the same as claim 1. The arguments presented above with respect to claim 1 are equally applicable to claim 4. Thus, it is respectfully requested the rejection be withdrawn.

Paragraph 5, on page 5 of the Office Action, claims 5 and 7-9 were rejection under 35 U.S.C. §103 as being unpatentable over Rubber Stamps in view of Checks Unlimited in view of Gottsman in view of Lemchen in view of Arledge and further in view of Tagawa, U.S. Patent No. 5,732,398. The rejection is respectfully traversed.

Tagawa deals with a travel network that includes a plurality of kiosks and innerconnective regional reservation centers to which the kiosks are attached. The system also includes the ability to contact agents for assistance as necessary. It is submitted that Tagawa does not overcome the deficiencies of the basic references with respect to claims 1 and 4 from which claims 7 and 5, 8 and 9 respectively depend. Thus, it is respectfully requested that the rejection be withdrawn.

It must also be noted that the wide diversity of references being applied are from a large number of different U.S. classes which brings into question whether one could realistically consider all these various arts relevant to Applicants' claimed invention. The diversity of

classes, which would probably provide sufficient basis for the U.S. Patent and Trademark Office to declare a Restriction Requirement if Applicants developed a number of claims, each directed to one of these classes, indicates the references were assembled solely on the basis of looking at Applicants' claims and then searching for the individual features, i.e., using hindsight analysis. Thus, it is submitted the Office Action has not presented a *prima facie* case of obviousness as it does not truly present a motivation for combining these disparate references.

In paragraph 6, on page 6 of the Office Action, claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamps in view of Checks Unlimited in view of Gottsman in view of Lemchen and further in view of U.S. Patent No. 5,495,430 to Matsunari et al. (hereinafter "Matsunari"). The rejection is respectfully traversed.

Applicants' claim 10 calls for the features substantially as found in claim 1 as well as an estimated time calculator that detects, upon receipt of each piece of e-mail from each of the customers by the e-mail receiver, a number of pieces of e-mail already received and operation conditions of the personalized product producing device, and, based on results of detection, calculates an estimated time of completion of the requested personalized product, wherein the e-mail returning device automatically returns a piece of e-mail further including the estimated time of completion to each of the customers. The alleged combination does not suggest the claim as Matsunari does not overcome the deficiencies of the basic references including a failure to have or suggest the automatic return of a piece of e-mail.

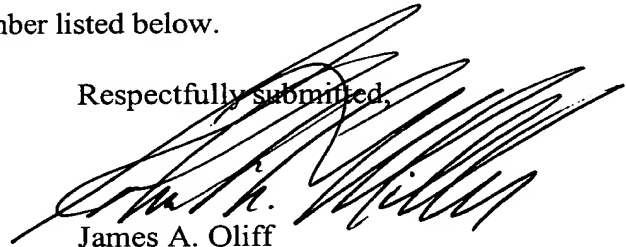
Matsunari is directed to a process time estimating apparatus for estimating the process time for manufacturing an object, such as a metal die (Abstract). Matsunari discloses a system that provides accurate estimates for complex manufacturing techniques to include learning during the manufacturing process. Nothing is said about the number of orders to be processed or of products to be produced, only the time for producing a piece. As such Matsunari clearly does not overcome the deficiencies of the basic references with respect to the other features of

claim 10 and certainly would not be looked to by one making the invention, only being looked to if one reads Applicants' claim and then starts to look for bits and pieces in an attempt to combine those bits and pieces to allege the invention. It is submitted that this teaching of Matsunari in combination with the other references does not create a *prima facie* case of obviousness. Thus it is respectfully requested the rejection be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:RAM/kap

Attachment:
Replacement Sheet

Date: June 1, 2004

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